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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/448,420 | 11/22/1999 | MICHAEL SEUL | 42970-3 | 5017 |

23973 7590 02/25/2003

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EXAMINER

PONNALURI, PADMASHRI

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1639

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary*Restriction Purposes Only*Application No.
09/448,420Applicant(s)
Seul et alExaminer
Padmashri PonnaluriArt Unit
1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 2, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 129-174 is/are pending in the application.
- 4a) Of the above, claim(s) 152 and 153 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 129-151 and 154-174 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☒ Other: *Restriction Fax cover sheet*

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DETAILED ACTION

1. The amendment F, filed on 10/15/02; and amendment G, filed on 12/02/02 have been fully considered and entered into the application.
2. New claims 160-163 have been added by the amendment F, filed on 10/15/02 and new claims 164-174 have been added by the amendment G, filed on 12/02/02.
3. Claims 129-174 are currently pending in this application.
4. Claims 152-153 are withdrawn from further consideration by the examiner, 37 CAR 1.142(b) as being drawn to a non-elected species election. Election was made **without** traverse in Paper No. 10.
5. A species election of the following is required of newly added claims to examine the application.

Please Note: In an effort to enhance communication with our customers and reduce processing time, a dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Andrew Wang, Supervisory Patent Examiner at andrew.wang@uspto.gov or 7(703)306-3217. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

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Election/Restriction

6. This application contains claims directed to the following patentably distinct species of the claimed invention: applicants are requested to elect a single compound in claim 167 as component.

Further, after selecting the compound in claim 167 applicants are further requested to elect a single species of the following:

- a) a group representing R_1 ;
- b) a group Representing R_2
- c) a group representing R_3 ;
- d) a group representing R_4 ;
- e) a group representing R_5 ;
- f) a group representing R_6 ;
- g) a group representing X;
- h) a group representing Y;
- I) a group representing Z;
- j) a group representing W;
- k) an integer representing a;
- l) an integer representing b;
- m) an integer representing c;
- n) an integer representing d;

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o) an integer representing e.

For this response to be complete and for search purposes, applicants should provide the chemical structure of elected compounds (or species), wherein each specific formula substituents of each of the above identified elected species are defined either by picture, or by expressing the species in terms of the variables of the formula.

The different components claimed are structurally and functionally are distinct from each other, thus species election between the groups is proper.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CAR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CAR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CAR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CAR 1.48(b) and by the fee required under 37 CAR 1.17(I).

Further the following clarification of the new claims is requested:

The new claim 172-173 seem to be different from the claimed invention. In the invention so far prosecuted in this application is drawn to a method of identifying a compound of interest in a library of compounds, by decoding a code composed of tags to identify the compound by in situ optical interrogation of the tags, which is different from the newly added claimed method.

Applicants are requested to clarify.

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9. Applicant is required to reply to this restriction requirement within 30 days of mailing this action. See MPEP 809.2(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Ponnaluri whose telephone number is (703) 305-3884. The examiner is on *Increased Flex Schedule* and can normally be reached on Monday to Friday from 7.00 AM to 3.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached on (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

P. Ponnaluri
Patent Examiner
Technology Center 1600
Art Unit 1639
20 February 2003


PADMAASHRI PONNALURI
PRIMARY EXAMINER